

Customer No. 32,127
Attorney Docket No. 01-1013

REMARKS

In the Final Office Action¹ mailed July 12, 2005, the Examiner objected to claim 26 under 37 C.F.R. § 1.75(c) as being in improper form and rejected claims 1-3, 5, 7-10, 12, 14, 22, 24, and 26-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,058,163 to Pattison et al. ("Pattison") in view of U.S. Patent No. 6,535,596 to Frey et al. ("Frey").

By this amendment, claims 22, 26, 27, 29, and 35 have been amended to correct grammatical and typographical errors. Claims 1-3, 5, 7-10, 12, 14, 22, 24, and 26-37 are currently pending.

A. Objection to Claim 26

Claim 26 was objected to under 37 C.F.R. § 1.75(c) as being in improper form because claim 26 depended from claim 25, which was cancelled in Applicant's amendment filed April 26, 2005. See Final Office Action, page 2. By this amendment, claim 26 has been amended to depend from claim 22, which is currently pending. Therefore, Applicant respectfully requests withdrawal of the objection to claim 26.

B. Rejections Under 35 U.S.C. § 103(a)

a. Rejection of Claims 1-3, 5, 7-10, 12, 14, 22, 24, and 26-31

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicant that such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

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Applicant respectfully traverses the rejection of claims 1-3, 5, 7-10, 12, 14, 22, 24, and 26-31 under 35 U.S.C. § 103(a) as being unpatentable over Pattison in view of Frey. No *prima facie* case of obviousness has been established with respect to claims 1-3, 5, 7-10, 12, 14, 22, 24, and 26-31 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

For example, independent claim 1 recites, among other things: "determining whether to establish the call connection." Claims 8 and 22 recite similar claim elements. Pattison and Frey, taken alone or in combination, fail to teach or suggest at least these elements of claims 1, 8, and 22.

In addition, the Examiner has shown no suggestion in the prior art of "determining whether to establish the call connection," as claimed. All actions on the merits issued by an Examiner must "be complete and clear as to all matters." 37 C.F.R. § 1.104(b). See also M.P.E.P. § 707.07 (8th ed., rev. 2, May 2004). Specifically, 37 C.F.R. § 1.104(c)(2) provides that:

"[I]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best reference at his or her command. *When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference ... must be clearly explained...*" (emphasis added).

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See also M.P.E.P. § 707 (8th ed., rev. 2, May 2004). Therefore, should the Examiner continue to reject claims 1, 8, and 22, as unpatentable under 35 U.S.C. § 103(a), Applicant requests that the Examiner provide specific citations to the references relied upon to support such a rejection. Applicant further requests that the Examiner withdraw the finality of the rejection and reopen prosecution of the present application. This would give Applicant a fair opportunity to review comments, feedback, or responsive arguments from the Examiner, and help Applicant advance the prosecution of the present application.

Moreover, independent claim 1 recites, among other things: "analyzing the recorded dial stream information to generate a result for the at least one analysis request; and providing the result to the requesting party." Claims 8, 22, and 27 recite similar claim elements. Pattison and Frey, taken alone or in combination, fail to teach or suggest at least these elements of claims 1, 8, 22, and 27.

The Examiner observed that Pattison does not teach "analyzing the recorded dial stream information to generate a result for the at least one analysis request." See Final Office Action, page 3. In an attempt to remedy this deficiency, the Examiner proposed combining Frey with Pattison. See Final Office Action, page 3. According to the Examiner, Frey teaches an "access module 117 [that] analyzes digits in order to recognize the type of information or services that are requested by the *calling party*." See Final Office Action, page 3 (citing Frey, col. 6, lines 43-55) (emphasis added). Thus, instead of "analyzing . . . and providing a result to the *requesting party*," as

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required by claim 1, Frey recognizes and responds to keypad inputs from a *calling party*. Frey, col. 6, lines 47-50. Moreover, the Examiner identified a supervisor in Pattison as the claimed "requesting party" and identified a caller to a call center as the claimed "calling party." See Final Office Action, page 2. In contrast, the system disclosed in Frey does not receive requests from a supervisor and any information or service resulting from recognized keypad input is provided only to the calling party. Therefore, Frey fails to teach or suggest generating a result that is provided to the supervisor in Pattison.

Therefore, there is no motivation for combining these references. The Examiner asserts that motivation can be found in providing "speed and convenience." See Final Office Action, page 3. This statement also is not something that the Applicant can respond to. It points to no evidence in the prior art to support combining the references. Nearly all inventions in this art can be said to have been motivated by "speed and convenience." To allow an Examiner to rely on this as a motivation without specific citations to the prior art would deny the Applicant a fair opportunity to rebut the *prima facie* case of obviousness established by the Examiner.

Accordingly, the 35 U.S.C. § 103(a) rejection of claim 1 and claims 2, 3, 5, 7, and 28-31, which depend from independent claim 1, should be withdrawn. Claims 8, 22, and 27, although of different scope, each contain elements corresponding to the elements of claim 1 discussed above and are allowable for at least the reasons discussed above with respect to claim 1. Claims 9, 10, 12, 14, 24, and 26 depend from

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and add additional features to independent claims 8 and 22. Accordingly, these claims are allowable for at least the reasons set forth above.

b. Rejection of Claims 32-37

Applicant respectfully traverses the rejection of claims 32-37 under 35 U.S.C. § 103(a) as being unpatentable over Pattison in view of Frey. No *prima facie* case of obviousness has been established with respect to claims 32-37 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims. For example, independent claim 32 recites, among other things:

"receiving a call connection request, the call connection request for a call connection between a first party and a second party, the first party permitting dial stream recording;

recording dial stream information associated with the call connection request in a record associated with the first party;"

The Examiner has shown no teaching or suggestion in the prior art of these claim elements. As mentioned above, all actions on the merits issued by an Examiner must "be complete and clear as to all matters." 37 C.F.R. § 1.104(b). See also M.P.E.P. § 707.07 (8th ed., rev. 2, May 2004). The rejection also fails to establish a legitimate motivation to combine the references. Therefore, should the Examiner continue to reject claim 32 as unpatentable under 35 U.S.C. § 103(a), Applicant requests that the Examiner provide specific citations to the references relied upon to support such a rejection. Applicant further requests that the Examiner withdraw the finality of the

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rejection to allow Applicant a fair opportunity to review comments, feedback, or responsive arguments from the Examiner and thereby advance the prosecution of the present application.

Conclusion

Applicant respectfully requests that this amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-3, 5, 7-10, 12, 14, 22, 24, and 26-37 in condition for allowance. Applicant submits that the proposed amendment of claim 6 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this amendment should allow for immediate action by the Examiner.

Furthermore, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's withdrawal of the finality of the rejection, entry of this amendment, reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there are any outstanding issues which need to be resolved to place the application in condition for allowance, the Examiner is invited to contact Applicant's

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undersigned representative by phone at the number indicated below to discuss such issues. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to deposit account 07-2347. With respect to this application, please charge any other necessary fees and credit any overpayment to that account.

Respectfully submitted,

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Dated: October 12, 2005

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